

REMARKS/ARGUMENTS

In the Office Action dated August 1, 2003, claims 1-37 were pending. Claims 1-37 stand rejected. Figures 1-3 and the Abstract were objected.

In this response, no claim has been cancelled. Claims 1, 15, 28, and 34 have been amended to particularly point out and distinctly claim, in full, clear, concise, and exact terms, the subject matter which Applicant regards as his invention. Replacement Figures 1-3 have been submitted. The Abstract has been amended. No new matter has been added. Reconsideration of this application as amended is respectfully requested.

Claims 1-3, 15-17, and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,097,389 of Morris et al. ("Morris") in view of U.S. Patent Application No. 2002/0021288 of Schug ("Schug"). Applicant hereby reserves the right to swear behind Schug in the subsequent prosecution of the present application.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). (Manual of Patent Examining Procedure (MPEP) ¶ 2143.03).

Applicant submits that independent claim 1 includes a limitation of accepting a cartridge having a slot for receiving a removable memory device to store a plurality of media objects, which is absent from Morris or Schug, individually or in combination. Examiner contends that Schug teaches the cartridge having a slot for a memory device at columns 2 and 4 of Schug (see, page 2 of the Office Action). Applicant respectfully disagrees. Schug fails to disclose or suggest a cartridge having a slot for receiving a removable memory device anywhere within the section relied upon by the Examiner (e.g., columns 2 and 4 of Schug). The only cartridge mentioned by

Schug is an APS film cartridge (see, paragraph 22 of Schug). However, the APS film cartridge is not the cartridge as claimed in the present application that includes a slot to receive a removable memory device and be able to transfer the media objects from the memory device to the cartridge as claimed in claim 2 of the present application. In fact, there is no mention of “slot” that can receive a memory card in Schug.

In addition, there is no suggestion to combine Morris with Schug. Since both Morris and Schug relate to a desktop video editing, there is no motivation to have an apparatus, such as a console as claimed in independent claims 28 and 34, to accept a cartridge having a slot to receive a removable memory card. Even if they were combined, such a combination still lacks the limitation of accepting a cartridge having a slot for receiving a removable memory device to store a plurality of media object. Therefore, independent claim 1 is patentable over Morris and Schug.

Similarly, independent claims 15, 28, and 34 include limitations similar to those referred by claim 1. Thus, for the reasons similar to those discussed above, independent claims 15, 28, and 34 are patentable over Morris and Schug.

With respect to claims 2-3 and 16-17, the Examiner stated:

“As to claims 2, 3, 16 and 17, while Morris et al. also discloses the plurality of media objects stored in the memory device being transferred to the cartridge, Schug shows the method of the memory device being inserted into the slot and the memory device being a flash memory card (column 2 and column 4).”

(8/1/2003 Office Action, page 2).

Applicant respectfully disagrees. As described above, neither Morris nor Schug discloses or suggests a portable cartridge having a slot to accept a removable memory device for storing media objects. Specifically, as claimed in claims 2 and 16, the media objects are transferred from the memory device to the cartridge when the memory device is inserted into the slot, which

is absent from either Morris or Schug, individually or in combination. In fact there is no mention of "cartridge" or "slot" in Morris.

Claims 4-14, 18-26, and 29-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morris in view of Schug and U.S. Patent No. 6,567,980 of Jain et al. ("Jain"). Applicant hereby reserves the right to swear behind Jain in the subsequent prosecution of the present application. Applicant submits that Jain also fails to disclose or suggest an apparatus or console to accept a portable cartridge having a slot to receive a removable memory device for storing media objects which can be displayed in a display coupled to the apparatus or console. Therefore, at least for the reasons set forth above, claims 4-14, 18-26, and 29-37 are patentable over the Morris, Schug, and Jain.

In addition, with respect to claims 4-7 and 18-21, claims 4-7 and 18-21 include a first track to display imported media objects, a second track to display authored stories, and a third track to display at least one story being authored (e.g., under construction) with optional background music added. These limitations are absent from Morris, Schug, or Jain, individually or in combination.

The Examiner contends that Fig. 17 of Jain discloses the above limitations. Applicant respectfully disagrees. Fig. 17 of Jain relates to a screenshot having one or more hyperlinks 908. Even if, for the sake of the argument, that cc-text frames 908 can be considered as authored stories, the cited references, individually or in combination still lack of the limitations discussed above, particularly, the third track to display one or more stories being authored or under construction.

The Examiner also contends that Jain (col. 9, line 58 through col. 10, line 8) discloses adding background music to the stories being authored as claimed in claims 7 and 21 of the

present application. However, the section (e.g., col. 9, line 58 through col. 10, line 8) of Jain relates in general to audio files or clips that have nothing to do with adding background music to the stories being authored.

With respect to claims 9-13 and 22-26, claims 9-13 and 22-26 include a game controller having a joystick and one or more control buttons, where the joystick is used to scroll among the first, second, and the third tracks and the one or more control buttons are used to add or delete the media objects in the third track, or alternatively, to specify an email address to send the media objects to a recipient. These limitations are completely absent from the cited references, individually or in combination.

The Examiner contends that Morris shows a joystick and the associated control buttons. However, the sections of Morris (e.g., col. 3, lines 47-67, and col. 4, lines 40-65) relied upon by the Examiner do not appear to disclose such limitations. In fact, there is no mention of a game controller, specifically, a game controller having a joystick in Morris at all. As discussed above, Morris relates to desktop software that is running at a desktop. In contrast, the present invention as claimed relates to a console (e.g., a game console) with a controller having a joystick and one or more control buttons (e.g., a game controller) to manipulate the media objects, without the complex desktop setup. The invention as claimed provides an end user a great flexibility and easier handling of media objects using a portable console type arrangement. Applicant submits that the above described limitations are completely absent from the cited references, individually or in combination. As a result, for the reasons discussed above, claims 1, 15, 28, and 34 are patentable over the cited references.

The rest of the claims depend from one of the above independent claims, thus include all of the distinct features of the respective independent claim, and therefore, for the reasons similar to those discussed above, are patentable over the cited references.

CONCLUSION


In view of the foregoing, Applicant respectfully submits the present application is now in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call the undersigned attorney at (408) 720-8300.

Please charge Deposit Account No. 02-2666 for any shortage of fees in connection with this response.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Date: 12/1, 2003



Michael J. Mallie
Reg. No. 36,591

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, California 90025-1026
(408) 720-8300